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In re Application of
WITTWER, Bruno
Application No.: 09/831,615
PCT No.: PCT/AU99/00992
Int. Filing Date: 10 November 1999
Priority Date Claimed: 10 November 1998
Attorney Docket No.: 19724-87004
For: PISTON PUMP

DECISION ON
RENEWED PETITION
UNDER 37 CFR 1.47(b)

This decision is in response to applicant's "Renewed Petition Under 37 CFR §1.47(b)," ("Ren.Pet.") filed 26 April 2002.

BACKGROUND

On 27 November 2001, a decision dismissing applicant's petition under 37 CFR 1.47(b) was mailed because applicant failed to satisfy all the required items.

On 26 April 2002, applicant submitted the instant renewed petition which was accompanied by, *inter alia*, a verified statement claiming small entity status; a declaration signed by the 37 CFR 1.47(b) applicant; a document titled "Declaration of Officer of Solar Energy Systems Pty Ltd" ("Maslin Decl."); a copy of a letter sent to Mr. Wittwer dated 05 April 2002; and copies of other documents previously submitted including the "Agreement" between Solar Energy Systems Pty Ltd. ("Solar") and Mr. Wittwer, a letter from Solar to Mr. Wittwer dated 22 June 2001, and an email sent by Mr. Wittwer to Greg Allen dated 14 August 2001.

DISCUSSION

As previously stated, a petition under 37 CFR 1.47(b) must be accompanied by (1) the requisite petition fee, (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. Applicant failed to satisfy items (2), (4), (5) and (6).

Item (2) of 37 CFR 1.47(b)

In the initial petition, the 37 CFR 1.47(b) applicant failed to show that Mr. Wittwer was presented with a complete copy of the application, including claims, specification and drawings. Therefore, the email dated 14 August 2001 was not deemed to be an express refusal since there was no evidence that the sole inventor was aware of all potential consequences of his refusal. See § 409.03(d) of the Manual Patent Examining Procedure (MPEP). In addition, it was requested that the 37 CFR 1.47(b) applicant submit a copy of the email on "9.7.01" referred to by Mr. Wittwer in his email dated 14 August 2001 along with any other documentary evidence such as letters, emails, etc. held by the 37 CFR 1.47(b) applicant that pertains to this refusal.

Here, applicant submitted a copy of a letter to Mr. Wittwer dated 05 April 2002 and accompanied with a copy of the Registered Post and Insurance form. In the letter from Wray and Associates, it was stated that a "Declaration and Power of Attorney for Patent Application, with attached specification (description, claims, drawings and abstract)" were submitted. This is sufficient to show that Mr. Wittwer was presented with a complete copy of the application.

However, the 37 CFR 1.47(b) applicant has not indicated what the response of Mr. Wittwer was to the documents submitted on 05 April 2002, if any. Any conduct deemed to be an express refusal or implied through his conduct must be demonstrated after receipt of the entire application which was only mailed in April 2002. Moreover, the 37 CFR 1.47(b) applicant still has not produced any other documentary evidence as requested in the prior decision.

For these reasons, item (2) is still not satisfied.

Item (4) of 37 CFR 1.47(b)

The 37 CFR 1.47(b) applicant included a declaration signed by attorney David J Simonelli for the 37 CFR 1.47(b) applicant "on behalf of Wittwer." Ren.Pet. at bottom of page 3. This does not meet the requirements outlined in section 409.03(a) of the MPEP which states, in part:

A corporation may authorize any person, including an attorney or agent registered to practice before the U.S. Patent and Trademark Office, to sign the application oath or declaration on its behalf. Where an oath or declaration is signed by a registered attorney or agent on behalf of a corporation, either proof of the attorney's or agent's authority in the form of a statement signed by an appropriate corporate officer must be submitted, or the attorney or agent may simply state that he or she is authorized to sign on behalf of the corporation.

In this case, there is no evidence that Mr. Simonelli has the authority to sign for

the 37 CFR 1.47(b) applicant. There is no statement signed by an appropriate corporate officer of Solar and Mr. Simonelli has not stated that he is authorized to sign the declaration on behalf of Solar.

For this reason, item (4) is still not satisfied.

Item (5) of 37 CFR 1.47(b)

The 37 CFR 1.47(b) applicant claims sufficient proof of proprietary interest by asserting that the invention has been assigned to Solar. The 37 CFR 1.47(b) applicant included an affidavit of Mr. Maslin, the Managing Director of Solar, who states that the above-captioned patent application which claims priority to two Australian priority applications (PP7013 and PP7390) were included in Schedule 1 of the Agreement that are being "developed by Wittwer as part of the BW Solar Business." Maslin Decl. at #6. Then Mr. Maslin concludes that in "this asset was sold to SES when the above-identified agreement was executed." *Id.* at #7.

This is not sufficient. The ownership of the patent (or the application for the patent) initially vests in the named inventor of the invention of the patent. See *Beech Aircraft Corp. v. EDO Corp.*, 990 F.2d 1237, 1248, 26 USPQ2d 1572, 1582 (Fed. Cir. 1993). Section 409.03(f) of the MPEP states that the "assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant." Section 306 of the MPEP also states, in part:

In the case of a substitute or continuation-in-part application, a prior assignment of the original application is not applied to the substitute or continuation-in-part application because the assignment recorded against the original application gives the assignee rights to only the subject matter common to both applications. Substitute or continuation-in-part applications require a new assignment if they are to be issued to an assignee.

Mr. Maslin has not explained whether international application PCT/AU99/00992 included any new matter not contemplated by provisional patents PP7013 and PP7390. Any new matter may or may not be part of the Agreement signed by Mr. Wittwer. See above. In addition, the 37 CFR 1.47(b) applicant still has not provided a statement under 37 CFR 3.73(b) by the assignee. See § 324 MPEP. Applicant also has not provided a statement from a person having first hand knowledge that the invention of the present application was made while Mr. Wittwer was in the employee of SES.

For these reasons, item (5) is also still not satisfied.

Item (6) of 37 CFR 1.47(b)

Counsel states in the renewed petition that "granting of this petition is a

necessary action to preserve the rights of Solar Energy to prevent the irreparable damage of loss of rights vis-à-vis priority to the invention disclosed in the above-captioned patent application.

This statement is sufficient to meet the requirements of item (6).

Accordingly, applicants failed to meet item(s) (2), (4), and (5) of CFR 1.47(b).

CONCLUSION

For the reasons discussed above, applicant's renewed petition under 37 CFR 1.47(b) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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